

R E M A R K S

- Claims **50 – 77** are currently pending.
- Of the pending claims, only claims **50, 71, 72 and 74** are independent.
- All of the pending claims stand rejected.

1. Terminal Disclaimer and Double Patenting

The terminal disclaimer filed on June 28, 2004 has not been accepted based on the Examiner's assertion that the terminal disclaimer was signed by an attorney or agent not of record. Applicants respectfully traverse this assertion and request reconsideration of the non-entry of the terminal disclaimer.

The terminal disclaimer was signed by Magdalena M. Fincham, whose Registration Number (46,085) was clearly presented on the last page of the response with which the terminal disclaimer was submitted. Registration Number 46,085 is a registration number associated with the customer number (22927) associated with the assignee of the present application, which customer number was clearly presented on the terminal disclaimer as well as on the first and last page of the response with which the terminal disclaimer was submitted. Applicants have included herein a copy of correspondence from the PTO which confirms that registration number 46,085 is assigned to customer number 22927.

In accordance with PTO policy, which is set out in MPEP 403 (describing "Customer Number Practice"), any attorney or agent whose registration number is assigned to a particular customer number is an attorney or agent of record and thus authorized to correspond with the PTO on behalf of the entity associated with the customer number.

In summary, since the terminal disclaimer was signed by an attorney whose registration number was at the time of the signing assigned to the customer number of the assignee of the application, the terminal disclaimer should have been accepted in accordance with PTO Customer Number Practice and Applicants respectfully request reconsideration of the non-entry of the terminal disclaimer.

In addition, Applicants respectfully request withdrawal of the obviousness-type double patenting rejection of claims **50 – 77** upon reconsideration of the non-entry of the terminal disclaimer.

2. Section 112 Rejection

Claim **57** stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. In particular, the Examiner points out that the limitation “the slot machine” of line 3 lacks antecedent basis. Applicants thank the Examiner for bringing this inadvertent error to Applicants’ attention. Claim **57** has been amended herein to recite “a slot machine” rather than “the slot machine”.

3. Section 102 Rejections

3(a). Rejection over Forte

Claims **50 – 53, 57, 58, 60, 61, 65 and 71 – 77** stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,586,766 to Forte (“Forte” herein). Applicants respectfully disagree with the Examiner’s interpretation of Forte and with the Examiner’s conclusion that the reference anticipates claims **50 – 53, 57, 58, 60, 61, 65 and 71 – 77** as pending before the amendments made herein. However, Applicants have amended claims **50, 71, 72, and 74** (the only independent claims of the rejected claims) herein to recite particular embodiments

of the invention that are not taught or suggested by Forte, solely to expedite allowance of the pending claims.

Specifically, Applicants have amended the rejected independent claims to claim particular embodiments of the present invention and thus to recite the following features, none of which is taught or suggested by Forte (as explained below):

- Claims **50 and 74** have been amended to recite the following feature:

wherein the expiration condition defines at least one of

(i) a number of plays, from a play in which an occurrence occurs, after which the occurrence expires and

(ii) a period of time, from a time at which an occurrence occurs, after which the occurrence expires, and further

wherein the expiration condition is associated with each respective occurrence, such that a first occurrence may expire at a first time and a second occurrence may expire at a second time that is different from the first time.

- Claim **71** has been amended to recite the following feature:

associating an expiration condition with each occurrence of the at least one tracked symbol wherein each occurrence of the at least one tracked symbol expires after its associated expiration condition has been satisfied, such that a first occurrence of the at least one tracked symbol may expire at a first time while a second occurrence

of the at least one tracked symbol may expire at a second time that is different from the first time

- Claim 72 has been amended to recite the following feature:

determining a count value wherein the count value is incremented when there is an occurrence of the at least one tracked symbol and the count value is decremented when an occurrence of the at least one tracked symbol expires, such that the count value may be a non-zero integer after the count value is decremented upon an expiration of an occurrence

Applicants note that Forte is limited to “zeroing” the count value (see, for example, Col. 4, lines 45 – 52) as the only method of decrementing a count value of jackpot triggering events. This is at least because Forte is limited to jackpot triggering events that are consecutive (see, for example, Col. 3, lines 43 – 44). Thus, if a hand does not include a jackpot triggering event, the count value necessarily has to be zeroed in order to only provide jackpots for consecutive jackpot triggering events.

Thus, Forte does not teach or suggest decrementing a count value to a non-zero integer (as claimed in amended claim 72), or of allowing a first occurrence of a symbol expire at a first time and a second occurrence of a symbol expire at a second time that is different from the first time (as claimed in amended claims 50, 71 and 74).

As Applicants noted in the Specification as filed, zeroing out of a count is undesirable because it results in “all player investment in [] the game are lost, and

the player may be motivated to cease play and search out another game.”

Specification, page 2, lines 13 – 14. See also, Specification, page 4, lines 13 – 21, which discusses the disadvantages of games that zero out all accumulated symbols. The claimed embodiments avoid or lessen the occurrence of such disadvantageous times in game play by allowing individual occurrences of a symbol to expire at different times, thus allowing for a non-zero count even after the expiration of one or more occurrences (which leaves a reason for a player to continue playing the game).

Applicants further respectfully submit that Forte does not enable allowing a first occurrence to expire at a first time while allowing a second occurrence to expire at a second time because Forte does not enable any means of determining a time at which an individual occurrence occurred. For that matter, Forte does not enable differentiating among individual occurrences of jackpot triggering events for any reason. The count of jackpot triggering events in Forte is treated as a single number that has a single condition associated therewith (the count is to be zeroed if a hand occurs that is not a qualifying hand), with no distinction being made (or able to be made) with respect to the occurrences that contributed to the count. In contrast, in the claimed embodiments an expiration condition is associated with each individual occurrence, thus allowing the flexibility of (i) having a first occurrence expire at a first time while a second occurrence expires at a second time that is different from the first time, and / or (ii) decrementing a count to a non-zero integer.

The rejected dependent claims **51 – 53, 57, 58, 60, 61 and 65** are each patentable at least because they each dependent from claim **50** and include each of the limitations of claim **50**.

Claim **52** is further patentable because it recites that the expiration condition “includes a number of plays after which an occurrence of the at least one tracked symbol expires”. Forte does not teach or suggest such a feature. The only feature of Forte that causes a decrement in a count (the decrement always being to zero) is an obtainment of a hand that is not a qualifying hand (e.g., a hand that is not a natural hand or a dealer hand that is not a bust) or the qualification for a bonus jackpot. While the zeroing of the count may occur after a number of plays has occurred (e.g., from an initiation of a count), a number of plays is not included in any expiration condition that governs play. Forte does not teach or suggest a passage of a number of plays causing an expiration of a symbol.

Similarly, claim **53** is further patentable over Forte because it recites that the expiration condition “includes a time after which an occurrence of the at least one tracked symbol expires”. Again, the only feature of Forte that causes a decrement in a count (the decrement always being to zero) is an obtainment of a hand that is not a qualifying hand or the qualification for a bonus jackpot. While the zeroing of the count in Forte may occur after a time has passed (e.g., from a time of initiation of a count), the time is not included in any expiration condition that governs play. Forte does not teach or suggest a passage of time causing an expiration of a symbol.

Similarly, with respect to claim **58**, Forte does not teach or suggest determining a bonus payout *based on a duration of time*. The amount of time that has passed (since any event, including an initiation of a count) is completely irrelevant to the determination of a bonus in Forte. For example, it would make

absolutely no difference in Forte whether a required number of consecutive jackpot triggering events occurred over a period of five minutes or one hour.

The rejected dependent claim 73 is patentable at least because it is dependent from claim 72 and thus includes each of the limitations of claim 72.

The rejected dependent claims 75 – 77 is patentable at least because it is dependent from claim 74 and thus includes each of the limitations of claim 74.

Further, claim 76 is also patentable over Forte for the same or similar reasons as claim 52.

3(b). Rejection over Mathis

Claims 50, 54 and 65 – 70 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,053,813 to Mathis (“Mathis” herein). Applicants respectfully traverse this rejection. Mathis does not teach or suggest any expiration condition that is used to determine a bonus payout and / or that may cause a count of occurrences of a symbol to be decremented.

4. Section 103 Rejections

Claims 55, 56, 59 and 62 – 64 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Forte. Applicants respectfully traverse this rejection at least because no *prima facie* case of obviousness has been made with respect to these claims.

No proper motivation to modify the reference has been provided. The stated motivations are merely statements of asserted advantages that may be realized from the proposed motivations. The motivations do not appear as objective

teachings in the record that would have motivated one of ordinary skill in the art to make the proposed modifications, as is required.

With respect to the rejection of claims **55, 56 and 59**, Applicants respectfully traverse that it was known at the time of Forte to store data associated with a player's progress in accumulating symbols in a game, in order to allow the player to accumulate the symbols "over multiple sittings", as the Examiner suggests. Applicants respectfully request a reference supporting this assertion.

With respect to claims **62 and 63**, Applicants respectfully traverse that it was known at the time of Forte to use a multiplier to apply to a payout and / or to determining points for a slot play reward system as a reward for accumulation of symbols. Applicants respectfully request a reference supporting this assertion.

With respect to claim **64**, Applicants respectfully traverse the rejection on the grounds that Forte does not teach or suggest "determining a payout for expired occurrences of the at least one tracked symbol." Forte does not teach or suggest performing any determination for expired occurrences of anything, much less determining a payout. Further, Applicants respectfully disagree with the Examiner's apparent assertion that not providing a payout and / or not disclosing any determination based on expired occurrences is equivalent to "determining a payout".

Further still, Applicants are confused as to why claim **64** is rejected over Forte under §103 (as opposed to §102(b)) if the Examiner's position is that Forte discloses all of the limitations of claim **64**. Applicants respectfully request clarification of this rejection.

CONCLUSION

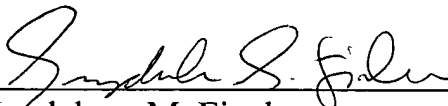
For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number (203) 461-7041 or via electronic mail at mfincham@walkerdigital.com.

Applicants do not believe any fee (e.g., for an extension of time with which to respond to the Office Action) is required at this time. However, if a fee should be necessary for the present Application at this time (or any time during the prosecution of the present Application), please charge any such required fee to our Deposit Account No. 50-0271. Please credit any overpayment to Deposit Account No. 50-0271.

Respectfully submitted,

December 30, 2004
Date


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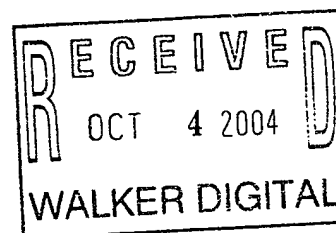


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